

### REMARKS

In this amendment, claims 1, 11, 14, 22, and 28 are amended and claim 21 is canceled. Upon entry of this amendment, claims 1, 2, 4, 5, 8-20, and 22-28 will be pending in the present application.

#### Claims 1, 2, 4, 5, 8-20, and 22-27

Applicant respectfully requests reconsideration of the rejections of claims 1, 2, 4, 5, 8, 9, 11, 14-16, 18, 19, and 22-27 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,536,425 (Kondo) in view of U.S. Patent No. 6,063,468 (Aratani), and claims 10, 12, 13, 17 and 20 as being unpatentable over Kondo in view of Aratani and further in view of U.S. Patent No. 5,864,357 (Akutsu). Claim 1 has been amended to include the subject matter previously recited in claim 21 and now recites a disc-shaped optical recording medium comprising a skew correcting member on a second of said two major surfaces of said support.

The Office Action rejected previous claim 21 as an unpatentable product-by-process, relying on *In re Thorpe*, which held that "(i)f the product in the product-by-process claim is the same as or obvious from a **product of the prior art**, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695 (Fed. Cir. 1985) (emphasis added). This holding necessitates a showing in the Office Action that the product, here a disc-shaped optical recording medium comprising, among other things, a skew correcting member is shown in or obvious from a **product of the prior art**. The Office Action does not show a skew correcting member or that such element would have been obvious as required by *Thorpe*. Rather, it appears that the Office Action attempts to reject a product, a disc-shaped optical recording medium comprising a skew correcting member, because an apparently related process or result of a product, a skew margin, is disclosed in the prior art. Such an approach is not compatible with the holding of *Thorpe*.

In *Thorpe*, the applicant disclosed a process of preparing the product of a color developer used in carbonless copy paper systems which implements, regarding the color developer a metal oxide or its functional equivalent, an ammonia base, and a mono-carboxylic acid. The prior art in that case taught the product of a color developer used in carbonless copy paper systems prepared by a different process. *Id.*, at 696. The applicant in *Thorpe* claimed a process and did not assert that the product of his process was different from the product of the prior art. *Id.*, at 697. In contrast, claim 1 of the present invention is a product claim, not a

process claim, and the product, a disc-shaped optical recording medium comprising a skew correcting member, is not shown in or obvious in light of the prior art.

Because the Office Action has failed to make a *prima facie* showing of obviousness as required by *Thorpe* regarding the elements of claims 1, 2, 4, 5, 8-20, and 22-27 as amended, the rejections of these claims are improper. Accordingly, Applicant requests the rejections be withdrawn.

#### Claim 28

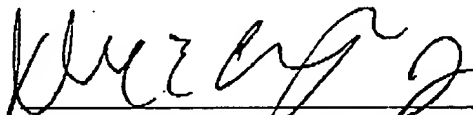
Applicant respectfully requests reconsideration of the rejection of claim 28 under 35 U.S.C. § 103(a) as being unpatentable over Kondo in view of Aratani. As amended, claim 28 includes subject matter previously recited in claim 22 and claim 23. Claim 28 recites a disc-shaped optical recording medium comprising, among other things, a skew correcting member on a second of the two major surfaces of the support, where the second of the two major surfaces is disposed on a side opposite to a side of the support on which the light transmitting layer is disposed, wherein the skew correcting member is formed by coating and curing a UV curable resin.

As explained in detail above regarding claim 1, neither the Office Action nor the prior art discloses or makes obvious a disc-shaped optical recording medium comprising a skew correcting member. Further, neither the Office Action nor the prior art discloses or makes obvious the skew correcting member formed by coating and curing a UV curable resin. Because the Office Action fails to make a *prima facie* showing of obviousness, the rejection of claim 28 is improper. Accordingly, Applicant requests the rejection be withdrawn.

#### Conclusion

As it is believed that the application is in condition for allowance, favorable action and a Notice of Allowance are respectfully requested.

Respectfully submitted,



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